

is hereby requested.

In the Office Action mailed July 13, 2001, newly added claims 26, 39, 45, 53 and 55-59 were withdrawn from consideration as being directed to inventions that are patentably distinct from the invention originally claimed. Applicants traverse this withdrawal from consideration according to MPEP 818.03. However, Applicants' response to the rejections under 102 and 103 has some bearing on Applicants' arguments. Therefore, Applicants will first overcome the prior art rejections and then provide support at the close of the present remarks for the traversal of the Examiner's restriction requirement and withdrawal of claims 26, 39, 45, 53 and 55-59.

Claims 18, 20, 24, 32 and 37 were rejected as being indefinite under 35 U.S.C. 112, second paragraph, because the Examiner was not certain what structure was being claimed. Claims 18, 24, 32 and 37 have been amended herein to more clearly indicate that the blade case comprises a handle. Therefore, the relationship between the blade case and the handle is more clearly defined. Claim 20 has not been amended, because claim 20 ultimately depends from claim 18 and further amendment of claim 20 is not believed to be required. Therefore, withdrawal of the Section 112, second paragraph rejection is hereby requested.

Claims 47 and 49 were finally rejected under 35 U.S.C. 102(b) as being clearly anticipated by the advertisement, Glass

Magazine, August 1998 (hereafter referred to as the DeGorter Ad). Further, claims 17-25, 27, 28, 30-38, 41-44, 48 and 50-52 were rejected under 35 U.S.C. 103(a) as being unpatentable over the device disclosed by the DeGorter Ad. Finally, claims 29, 40, 46 and 54 were finally rejected as being unpatentable over the device shown in the DeGorter Ad in view of Moll, 945.

Although Applicants disagree with Examiner's grounds for entering this rejection, the Examiner is requested to take notice that the publication date of the DeGorter Ad (August 1998) is less than 1 year before the filing date of this application (July 9, 1999). Therefore, Section 102(b) can not be applied and instead, only a tentative Section 102(a) rejection is warranted. However, the Examiner is further requested to take notice that the DeGorter Ad was published after the filing date of Applicants' Japanese priority application (July 9, 1998). Therefore, in accordance with MPEP 201.15, Applicants hereby submit a certified English translation of Japanese patent application serial number 10-194448, which was filed in the Japanese Patent Office on July 9, 1998. This certified copy is seasonably presented, because it is being submitted in response to a first action based upon a newly cited, Section 102(a) reference. Therefore, reconsideration and withdrawal of the prior art rejections is hereby requested. Representative, but not limiting, support for the presently pending claims can be found in the attached

English translation of JP 10-194448 as follows:

Claim 17: Figures 1 and 5-11; page 2, lines 16-25, page 3, line 20 - page 4, line 5, page 5, lines 4-30, page 10, lines 21-32

Claims 18, 20, 21, 24, 34, 37, 48, 52: Figure 1; page 2, lines 27-31, page 6, lines 4-10, page 7, lines 12-15

Claims 19, 25, 33, 38: Figure 1; page 2, line 32 - page 3, line 2, page 6, lines 5-10

Claims 22, 23, 50: Figures 5-7; page 3, lines 20-30, page 9, line 26 - page 10, line 14

Claims 26, 39, 45, 54: Figure 1; page 6, line 32 - page 7, line 2, page 7, lines 16-18

Claim 27: Figures 1 and 5; page 10, lines 3-5

Claims 28, 42, 51: Figures 1 and 5; page 10, lines 27-29

Claims 29, 40, 46: Figure 1; page 6, lines 28-31, page 7, lines 19-21

Claims 30, 35: Figures 10 and 11; page 12, lines 20-22

Claims 31, 36: Figures 10 and 11; page 12, lines 8-10

Claims 34, 47, 49: Figures 1, 2 and 5-11; page 2, lines 16-25, page 3, line 20-page 4, line 5, page 5, lines 4-30, page 7, lines 25-27, page 10, lines 21-32

Claims 41, 43: Figures 5-7; page 2, lines 16-25, page 3, lines 20-30, page 5, lines 4-30, page 9, line 26 - page 10, line 14

Claim 44: Figure 1; page 2, line 27 - page 3, line 2, page 6, lines 4-10, page 7, lines 12-15

Claims 55, 56: Figures 3 and 4; page 2, lines 16-25, page 3, lines 4-19, page 5, lines 4-30, page 8, line 10 - page 9, line 24

Claim 57: Figures 3 and 4; page 9, lines 11-13

Claim 58: Figures 3 and 4; page 8, lines 13-15

Claim 59: Figure 4; page 9, line 24-25

Thus, because the Japanese priority application fully

supports all the pending claims and has a filing date earlier than the publication date of DeGorter, the rejections based upon DeGorter should be withdrawn and at least claims 17-54 should be allowed.

Returning to the Examiner's withdrawal of claims 26, 39, 45 and 53, each of these claims depends from independent claims are now in a condition for allowance. Therefore, pursuant to MPEP 806.04(d) and 809.02(c)(B)(1), rejoinder of claims 26, 39, 45 and 53 is hereby requested and, in fact, required by the MPEP.

The Examiner also withdrew claims 55-59 as being "different than those originally presented and acted on, the species being directed to a battery mounting device disposed within the side surface of the auxiliary table, and the various mounting positions on the table." To the contrary, it is respectfully noted that the original application included claims 4-7, which are reiterated herein for the Examiner's convenience:

4. A table saw as defined in claim 1 further including a base for supporting said table, said battery mounting device being mounted on said base.

5. A table saw as defined in claim 4, wherein said table is

rotatably supported on said base and has a pair of auxiliary tables positioned on both sides of said table in opposed relationship with each other substantially in the diametrical direction of said table, wherein said battery mounting device is mounted on one of said auxiliary tables.

6. A table saw as defined in claim 5, wherein said table can rotate in opposite directions from a reference position within a predetermined angle, said motor is positioned on one side of said saw unit closer to one of said auxiliary tables when said table is in said reference position, and said battery mounting device is disposed on the other of said auxiliary tables, so that the battery mounted on said battery mounting device can serve as a counterweight to the moment of said motor.

7. A table saw as defined in claim 6, wherein said saw unit is mounted on a peripheral part of said table, so that said saw unit is positioned on one side in forward and rearward directions that is substantially perpendicular to the diameter of said table across said auxiliary tables when said table is in said reference position, said battery mounting device on the other of said auxiliary tables is positioned on the other side of said forward and rearward directions, so that the battery mounted on said battery mounting device can serve as a counterweight to the moment of said saw unit.

In view of the supporting disclosure for these claims, e.g., at page 13, lines 4 - page 14, line 19 and Figures 3 and 4, Applicants can not understand the Examiner's reasons for considering that claims 55-59 are "different" from originally presented claims 4-7. In fact, originally presented claims 1 and 4 are generic to claims 55-59 and the Examiner previously fully examined claims 1 and 4-7 in the first Office Action without entering a species election requirement. In fact, claims 55-59 merely define claimed inventions that clearly fall within the scope of original presented, generic claims 1 and 4. Therefore, claims 55-59 can not be directed to a "different" invention, but rather a clarification of the previously presented claims.

Moreover, it is respectfully submitted that the Examiner has not satisfied the requirements of a proper restriction requirement for restriction between patentably distinct inventions. Specifically, MPEP 803 states: "If the search and examination of an entire application can be made without serious burden, the examiner MUST examine it on the merits, even though it includes claims to independent or distinct inventions." (Emphasis added) Further, the Examiner has failed to establish a serious burden to examine claims 55-59 in this application, which is one of the two criteria for a proper restriction between patentably distinct inventions. Id. For example, the Examiner has failed to show by appropriate

explanation either separate classification, separate status in the art, or a different field of search as defined by MPEP 808.02. Id. (See also, MPEP 811 "Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." (Emphasis added))

If the Examiner elects to maintain the restriction of claims 55-59, Applicants hereby request the Examiner according to MPEP 821.01 to respond to Applicants' arguments and specifically identify the serious burden imposed upon the Examiner to examine claims 55-59 in this application in order to properly frame the issues for further reconsideration of this restriction requirement. In the alternative, the Examiner is hereby requested to allow claims 17-59 and an early Notice of Allowance for all pending claims is earnestly solicited.

Respectfully submitted,
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IN THE CLAIMS:

18. (Once Amended) A table saw as in claim 17, wherein the blade case further comprises a handle [further comprising a handle integrally extending from the blade case, the handle] having a rear portion defined closest to the pivotal axis and a front portion defined farthest from the pivotal axis, wherein the battery mounting device is disposed at the rear portion of the handle.

24. (Once Amended) A table saw as in claim 23, wherein the blade case further comprises a handle [further comprising a handle integrally extending from the blade case, the handle] having a rear portion defined closest to the pivotal axis and a front portion defined farthest from the pivotal axis, wherein the battery mounting device is disposed at the rear portion of the handle.

32. (Once Amended) A table saw as in claim 31, wherein the blade case further comprises a handle [further comprising a handle integrally extending from the blade case, the handle] having a rear portion defined closest to the pivotal axis and a front portion defined farthest from the pivotal axis, wherein the battery mounting device is disposed at the rear portion of the handle.

37. (Once Amended) A table saw as in claim 34, wherein the blade case further comprises a handle and [further comprising a handle integrally extending from the blade case, wherein] the battery mounting device is disposed on the handle.